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In the Supreme Court of the United States

OCTOBER TERM, 1948

No. ~~195~~ 479

GRAVER TANK & MFG. CO., INC.,
THE LINCOLN ELECTRIC COMPANY,
GRAVER TANK & MFG. CORPORATION,
Petitioners,

vs.

THE LINDE AIR PRODUCTS COMPANY,
Respondent.

ON WRIT OF CERTIORARI TO COURT OF APPEALS FOR SEVENTH CIRCUIT.

PETITIONERS' PETITION FOR REHEARING.

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March 11, 1949.

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Petitioners, on the grounds following, petition for rehearing of so much of this Court's judgment as holds flux claims 18, 20, 22, and 23 infringed:

1. Ruling of law mistakenly treated as finding of fact. The Court has affirmed the judgment as to infringement on the ground it rests upon a question of fact. In truth the trial court's judgment of infringement rests, not upon any finding of fact, but upon a reading of the language of the patent. This, as all cases hold, and as this Court's opinion in overthrowing the other flux claims recognizes, is a pure question of law.

Each of the claims held infringed is unambiguously limited to a flux "containing a major proportion of *alkaline earth metal* silicate."[1]

But the trial court found as facts:

1. That the accused Lincoln flux is composed in major proportion of *manganese* silicate. Said the trial court, "Essentially the accused welding composition comprises manganese silicate to which has been added a small amount of calcium fluoride" (R. 919, Finding 21, R. 926).
2. That the manganese Lincoln used *"is not an alkaline earth metal"* (Finding 12, R. 925).[2]

Accordingly, as the trial court found, "Since the accused flux is composed principally of manganese silicate, it does not literally infringe composition claims 18, 20, 22 and 23" (R. 919-20).

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[1] The alkaline earth metals are calcium, magnesium, strontium and barium (Finding 11, R. 925). The claims read:

"18. A composition for electric welding *containing a major proportion of alkaline earth metal silicate*, and being substantially free from uncombined iron oxide and from substances capable of evolving gases under welding conditions.

20. A composition for electric welding containing a fluoride and a *major proportion of alkaline earth metal silicate*, and being substantially free from uncombined iron oxide and from substances capable of evolving gases under welding conditions.

22. A finely-divided unbonded fusible electric welding composition containing a fluoride and a *major proportion of an alkaline earth metal silicate*.

23. A finely-divided unbonded fusible composition for use in electric welding employing a bare metal electrode as a source of weld metal, said composition being substantially free from substances capable of evolving a detrimental quantity of gas under welding conditions and containing calcium fluoride and a *major proportion of one or more alkaline earth metal silicates*." (R. 960.)

[2] Emphasis supplied throughout.

The trial court, however, found infringement by reading these claims, confined to alkaline earth metal silicates, to cover also manganese silicate, which, as the trial court found, is not an alkaline earth metal silicate. The question of law—namely, the extent of the grant—the trial court resolved by reading the specification into these claims. This is the way the trial court solved that question:

> "In the patent [that is, in the specification, R. 956, col. 1, lines 62-5] the inventors state, 'We have used calcium silicate and silicates of sodium, barium, iron, manganese, cobalt, magnesium, nickel and aluminum, both in binary and ternary combinations, in various proportions.' Thus, the fact that manganese is a proper substitute for calcium silicate as a major ingredient of the welding composition invented by Jones, Kennedy and Rotermund is fully disclosed *in the specification* of their patent." (R. 920.)

Accordingly, the trial court found:

> "Manganese silicate is one of the nine metallic silicates *which the specification discloses* that the inventors have used as principal constituents in welding compositions attaining more or less effectively the objectives of their invention" (Finding 13, R. 925).

Thus, because the manganese silicate Lincoln used is named in the specification as one of the nine the inventors used, the trial court read claims 18, 20, 22 and 23 to cover not only the alkaline earth metal silicates, to which these claims are confined, but expanded them to embrace also manganese silicate which is not claimed. But this, as this Court recognized in holding invalid claims 24 and 26, cannot be done. This Court said:

> "The statute makes provision for specification separately from the claims and requires that the latter 'shall particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery.' R. S. § 4888, as amended, 35 U. S. C. § 33. It would accomplish little to require that claims be separately written if they are not to be

separately read. While vain repetition is no more to be encouraged in patents than in other documents, and claims like other statements may incorporate other matter by reference, their text must be sufficient to 'particularly point out and distinctly claim' an identifiable invention or discovery. We have frequently held that it is the claim which measures the grant to the patentee. See, for example, *Mileor Steel Co. v. Fuller Co.*, 316 U. S. 143, 145; *General Electric Co. v. Wabash Co.*, 304 U. S. 364, 369; *Altoona Theatres v. Tri-Ergon Corp.*, 294 U. S. 477, 487. While the cases more often have dealt with efforts to resort to specifications to expand claims, it is clear that the latter fail equally to perform their function as a measure of the grant when they overclaim the invention. When they do so to the point of invalidity and are free from ambiguity, which might justify resort to the specifications, we agree with the District Court that they are not to be saved because the latter are less inclusive. *Cf. General Electric Co. v. Wabash Co.*, 304 U. S. 364, 373-374; see *McClain v. Ortmayer*, 141 U. S. 415, 424-425; *Cimiotti Unhairing Co. v. American Fur Refining Co.*, 198 U. S. 399, 410" (Slip Opinion, p. 6).

What this Court thus says on page 6 of the slip opinion *cannot* be done, it *has* done on page 5. To this result the Court has come by failing to note that the trial court's judgment of infringement rests not upon a finding of fact but turns solely and entirely on a point of law. Manifestly, the rule which destroys claims 24 and 26 necessarily bars any finding of infringement of claims 18, 20, 22 and 23.

That the trial court's judgment of infringement rests upon a point of law is plain. The trial court, as its opinion makes clear, found infringement only by expanding the claims to make them cover a composition admittedly not covered by the claims as written. Accordingly, because it was dealing with a question of law and not of fact, the trial court declared the infringement, not as a finding of fact, but as a conclusion of law (Conclusion 4, R. 928).

The trial court thus clearly understood that what it was ruling on was a point of law—namely, the measure of

the grant--whereas this Court has affirmed as though the judgment of infringement rested upon facts found. The facts found show no infringement; if to those facts is applied the rule of law this Court applied to flux claims 24 and 26, and has always applied, there can be no infringement.

The vice of the construction by which the judgment of infringement is affirmed is that it expands the claims by resort to the specifications in the teeth of the Court's assertion that this may not be done. Not only does the judgment of affirmance mutilate the law in this respect, but its effects will be far-reaching. If the manganese silicate Lincoln used is to be culled from the list of nine in the specification, and read into the claims, so also must each of the remaining eight. As a consequence, many fluxes now in the public domain must likewise infringe the present patent. (See petitioners' opening brief, pp. 7 and 57-67.)

Moreover, new uncertainty is introduced into the patent law. The public no longer can rely on the claims of the patent as written to define, like the metes and bounds of a deed, the area from which it is excluded. It must speculate whether, and, if so, how much of, the specification is to be read as a claim. This risk not many will care to assume. The result will be that by deft use of specifications, operating *in terrorem*, otherwise clear-cut claims can be used to exclude the public from an additional penumbral area to which the patent owner in law has no title.

This Court noted:

> "He [the trial judge] concluded that what was really invented was that which was claimed and bounded by the composition claims Nos. 18, 20, 22 and 23" (Slip Opinion, p. 3).

Those claims have now been held valid. They, along with the other claims not in issue, give the patentees every protection to which they are entitled. Plaintiff retains a monopoly on the flux which it has successfully exploited

(Finding 9, R. 925). There is no call to expand that monopoly beyond the terms of the grant.

2. Fact findings misread. This Court has erroneously assumed that:

> "the District Court found that the Lincoln Electric Co. made, and the other petitioners used and sold, a flux substantially identical with that set forth in the valid composition claims" (Slip Opinion, p. 5).

The District Court did not so find. It did not find the accused flux was "substantially identical." It found:

> "The two compositions are identical *in operation*, and the same kind of weld is produced by them" (R. 919); and
>
> "The accused Lincolnweld flux and the composition of the patent in suit are substantially identical *in operation* and *in result*" (Findings 20, 21, R. 926).

They are not the same and the trial court did not so find. They are merely the same "in operation and in result."[3] But a patent cannot cover a result. There may be

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[3] The District Court was wrong in concluding that the four claims in question were infringed in view of the express finding that the "means" employed, viz. petitioners' manganese silicate, were different from the means, viz. alkaline earth metal silicate, to which the claims are restricted. *Eames v. Godfrey* (1863), 1 Wall. 78, 80.

The effect of the holding of infringement is to give such last-defined material, which is the crucial element in the claim, a functional definition. By the same token any compound "substantially identical in operation and in result" would infringe. Had the material of the claims been defined in such functional terms, such a description would have been held invalid as a violation of Rev. Stat. § 4888. *Holland Furniture Company v. Perkins Glue Company* (1928), 277 U. S. 245, 256-57; *General Electric Co. v. Wabash Electric Corp.* (1938), 304 U. S. 364, 370-1; *Halliburton Oil Well Cementing Co. v. Walker* (1946), 329 U. S. 1, 9. Here as a result of this Court's adoption of the District Court's mistaken conclusion, on the assumption it was a finding of fact, "the broadness, ambiguity and over-hanging threat of the functional claim," thus constituted, of each of the four claims in issue becomes apparent, just as much as in the *Halliburton* case.

many compositions—indeed, many may still be unknown—producing the same result. The patentees have claimed a specific type; it does not follow that any other producing the same result infringes.

In short, the trial court on the issue of infringement found three facts. The accused flux is a manganese silicate. Manganese silicate is not an alkaline earth metal silicate. Manganese silicate as used produces the same result as an alkaline earth metal silicate. The first two facts repel the thought of infringement. The third affects only the result and results as such are never patentable.

3. Erroneous rule applied. This Court has applied a rule likely to plague it and the patent law in cases to come, in saying:

> "The petitioners introduced no evidence to show that their accused flux was derived either from the prior art, by independent experiment or from any source other than the teachings of the patent in suit" (Slip Opinion, p. 5).

Suppose petitioners had introduced that evidence. Assuming it admissible, it would not have been a defense. Petitioners' case would have been neither better nor worse. Either the flux infringes or it does not; and, if infringing, it can no more be saved by proof of independent discovery than it could be condemned, if noninfringing, by proof it was derived from the patent. That is the rule flowing from the statute itself, which this Court until now has in fact always applied. Indeed, the very purpose of the statute in requiring the inventor to "particularly point out and distinctly claim" the invention is to free the public to build on the past.

The probability that the judgment of infringement has been affirmed under misapprehension is so great that this Court should grant rehearing on that issue. This question arises only in cause No. 185 which brought to this

Court the flux claims held infringed; accordingly rehearing is asked only in that case, and not in companion cause No. 184.

Respectfully submitted.

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CERTIFICATE.

The foregoing petition for rehearing is believed to be meritorious and is presented in good faith and not for delay.

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